reallocating the buffer block to be overwritten if no storage tag exists or after the data has been stored to the media file if a storage tag exists.

REMARKS

In response to the above-identified Office Action, Applicant has amended the application and seeks reconsideration thereof. Claim 2 has been canceled. No claims have been added. Claims 1, 4, and 6-8 have been amended. Applicant submits that in amending the claims, no new matter has been added that would require an additional search for prior art. Accordingly, Claims 1 and 3-18 are pending.

I. Specification

The Examiner objected to the disclosure for informalities. Applicant has amended the specification above to conform with the Examiner's recommendation. Approval is hereby requested.

II. Claims Rejected Under 35 U.S.C. § 102(e)

The Examiner rejected Claims 1-15 and 17-18 under 35 U.S.C. 102(e) as being anticipated by Iizuka (U.S. Patent Reg. No. 5,642,492, hereinafter "Iizuka"). Applicant has amended Claim 1 above in response to the rejection. The elements introduced have already been examined by virtue of their prior inclusion in Claim 2. Accordingly, the amendment raises no new issues and better positions the case for appeal. Entry of the amendment is respectfully requested.

Applicant first notes that it is axiomatic that to anticipate a claim, every element of the claim must be disclosed within a single reference. Amended Claim 1 and original Claim 9 both store media files from a buffer onto mass storage devices (Claim 1, lines 5 and 6; and Claim 9, lines 6 and 7). Claims 1 and 9 also employ media files with record handles or media samples, respectively, (Claim 1, line 8; Claim 9, lines 7-10) before the punch in point and after a punch out

point. Iizuka neither teaches nor suggests the use of record handles or media samples after punch out in the manner of Claims 1 and 9.

Iizuka discloses a digital recorder employing punch-in and punch-out processes. In particular, the Examiner asserted that "data g" corresponds to a second record handle. In order for this to be correct, Iizuka would necessarily teach data g being stored as part of the media file on the mass storage device. However, Iizuka only writes data g to the buffer, not storing it as punch-in data in the hard disk (Fig. 16; Col. 22, lines 15-19). Thus, Iizuka neither teaches nor suggests using the record handles or media samples after punch out of Claims 1 and 9 since data g is not a part of the media file stored on the mass storage device.

Therefore, Applicant respectfully requests that the rejection of amended Claims 1 and 9 and their respective dependent claims be withdrawn. Applicant contends that a number of the features of the dependent claims are also not present in the reference. However, as those claims are all also patentable as dependent on a patentable independent claim, no further argument need be presented here. It is submitted that the Examiner should revisit each dependent claim as reliance on the cited passages appears to be largely misplaced. It is particularly noted that the Examiner has given short shrift to Claims 7, 8, and analogous claims depending from Claim 9. Simply put, the passages cited by the Examiner fail to support the rejection, and Applicant has been unable to identify any more supportive passages within the reference. Applicant notes that the detail of Iizuka's discussion cited by the Examiner vis-à-vis storage (Col. 25, lines 18-32, 42-50; Col. 29, lines 19-33) is irrelevant where, as here, it fails to match that which Applicant claims.

III. Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected Claim 16 under 35 U.S.C. 103(a) as being unpatentable over Iizuka. Applicant respectfully traverses this rejection.

For the reasons discussed above, Applicant submits that Claim 9, upon which Claim 16 is dependent, is neither taught nor suggested by Iizuka. Therefore, Applicant respectfully requests withdrawal of the rejection of Claim 16.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance, and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

Dated: November 13, 2000

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Thomas M. Coester, Reg. No. 39,637

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Non-Fee Amendment - Final, Assistant Commissioner for Patents, Washington, D.C. 20231, on November 13, 2000.

Laura Harmon November 13, 2000